

U.S. Serial No.: 10/762,840
Filed: January 22, 2004
Group Art Unit: 3732
Examiner: David Cornstock
Atty. Docket No.: 101896-237 (DEP-804CNT)

REMARKS

The pending Office Action addresses claims 1-6, 8, and 10-24. At the outset, Applicants thank the Examiner for allowing claims 18-24. Claims 1-6, 8, and 10-17 stand rejected. Applicants respectfully request reconsideration of these claims in view of the remarks below.

Rejections Pursuant to 35 U.S.C. §102(e)

The Examiner rejects claims 1-6, 8, 14, and 15 pursuant to 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0045935 of Angelucci et al. The Examiner argues:

It is noted that to be entitled to weight in method claims, the recited structure limitations therein must affect the method in a manipulative sense, and not amount to the mere claiming of a use of a particular structure. *Ex Parte Pfeiffer*, 1962 C.D. 408 (1961). Here, the new limitations do exactly that – merely claim the use of a particular structure, i.e. the body having opposed ends and a perforation-free side or having a particular prosthetic process as set forth in claims 1 and 15, respectively.

Applicants respectfully disagree.

Claims 1-6, 8, and 14

The structure recited in independent claim 1 does affect the method in a manipulative sense, as it requires that the implant be positioned in a particular orientation. Specifically, claim 1 requires that the implant include cephalad, caudal, and posterior sides having a plurality of elongate slots formed therein, and a slot-free anterior side. Claim 1 further requires that the slot-free anterior side *be positioned adjacent to the spinal cord*. Such a configuration therefore affects the method in a manipulative sense, and thus the structural limitations must be given patentable weight. Accordingly, independent claim 1 distinguishes over Angelucci, as Angelucci does not teach or even suggest the claimed method. Claims 2-6, 8, and 14 are allowable at least because they depend from allowable claim 1.

Claim 15

The structure recited in independent claim 15 likewise affects the claimed method in a manipulative sense, and therefore must be given patentable weight. Independent claim 15 recites a method for implanting a medical device that includes positioning an elongate body between the two halves of a bisected spinous process to enlarge a spinal canal formed within the vertebra. Claim 15

U.S. Serial No.: 10/762,840
Filed: January 22, 2004
Group Art Unit: 3732
Examiner: David Comstock
Atty. Docket No.: 101896-237 (DEP-804CNT)

further requires that the elongate body include a spinous process replacement member that extends outward therefrom and that is *adapted to mimic the spinous process* before it is bisected. The recited spinous process replacement member therefore affects the method as it is necessary in order to mimic the spinous process before it is bisected. Angelucci does not teach an implant having anything that can be considered to be a spinous process replacement member, as previously agreed by the Examiner, and therefore Angelucci cannot teach a method of positioning an implant such that a spinous process replacement members mimics the spinous process before it is bisected. Accordingly, independent claim 15 distinguishes over Angelucci and represents allowable subject matter.

Rejections Pursuant to 35 U.S.C. §103

The Examiner rejects dependent claims 10-13 as being obvious over Angelucci in view of U.S. Patent No. 6,132,464 of Martin. The Examiner also rejects dependent claims 16 and 17 as being obvious over Angelucci in view of U.S. Patent No. 6,419,703 of Fallin et al. While the Examiner has previously agreed that claims 10-13 distinguish over Angelucci in view of Martin, and claims 16 and 17 distinguish over Angelucci in view of Fallin, the Examiner now rejects claims 10-13, 16, and 17 on the basis that the structural limitations cannot be given patentable weight. For reasons discussed above, the structural limitations recited in independent claims 1 and 15 must be given patentable weight. As previously agreed, these structural limitations distinguish over Angelucci in view of Martin and/or Fallin, and therefore dependent claims 10-13, 16, and 17 are allowable.

Conclusion

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

Date: June 15, 2005

Nutter McClennen & Fish LLP
World Trade Center West
155 Seaport Boulevard
Boston, MA 02210
Tel: (617)439-2550
Fax: (617)310-9550

Respectfully submitted,



Lisa J. Michaud, Reg. No. 44,238
Attorney for Applicant(s)

BEST AVAILABLE COPY